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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,033	11/17/2003	Akio Ikeda	137522-1	1032

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CANTOR COLBURN LLP
55 GRIFFIN RD SOUTH
BLOOMFIELD, CT 06002

EXAMINER

BOYKIN, TERRESSA M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,033

Applicant(s)

IKEDA ET AL.

Examiner

Terressa M. Boykin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Telephone Interview 2-3-05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4, 6 - 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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***The Finality of the office action has been withdrawn.**

35 U.S.C. 112

Claims 1, 3, 6 - 15, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention., i.e. the phrase "**adjusted before**".

With regard to applicants' arguments regarding the 112 rejection, applicants allege that the term "adjusting before" is fully defined in the specification in paragraphs 0055, 0060, 0064, 0068 and 0070. However, no such language, (page, paragraph etc.) from the specification has been supplied. The paragraphs to which the applicants' refer do not state such language and may be interpreted otherwise. For example, note paragraph 0060. the paragraph reads "*During the polycondensation reaction or/and transesterification reaction , the OH groupis adjusted, in advance,.....* This may be interpreted to mean that *within the polycondensation reaction* the OH is adjusted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 6-15 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2003/0065130 see pages 1- 5, tables 1-3 and claims 1- 13. Note previous rejection.

With regard to applicants' arguments regarding the 102 rejection, it is noted that the description of an adjustment or specific step on how/what the adjustment is accomplished in paragraph [0074] of applicants' specification discloses that a terminal regulator is added *during the melting* of the polycarbonate resin waste. Additionally, it is further noted that applicants term "waste" is inclusive of the "recyclate" since applicants process is recycling or continuous. As stated previously, and reiterated by applicants, paragraph [0018] of the reference also notes the polycarbonate "is adjusted in the melt....". Which is again identical to applicants' argument and claims. Note also, with regard to claim 4 etc. that Hansen states in the abstract that the polycarbonate to be adjusted may be in the form of waste, or recyclate which would mean that the "adjustment" , *depending upon ones perspective of the continuing process when viewed*, could be considered either before, during or after either the transesterification or the melt polycondensation, i.e. it is in a loop reaction. Lastly, with regard to claim 16 etc. the use of a mixing tank is with no specific characteristics etc. is considered to be anticipated by the art since a mixing tank is used therein.

Consequently, the claimed invention continues to not be deemed as novel and accordingly is unpatentable.

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Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov <<http://www.uspto.gov>>), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <<http://www.uspto.gov/ebc/index.html>> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Terressa Boykin, via the receptionist whose telephone number is (703) 308-2351. The examiner can normally be reached on Monday through Friday from 8:00a.m.-5:30 p.m.

tmb

A handwritten signature in black ink, appearing to read "Terressa Boykin". The signature is written in a cursive, flowing style.

**Examiner Terressa Boykin
Primary Examiner
Art Unit 1711**